UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,485	11/14/2003	Kevin L. Tally	10628.00087	1038

22908 7590 01/25/2005

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

EXAMINER	
HAN, JASON	

ART UNIT	PAPER NUMBER
2875	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/714,485	TALLY, KEVIN L.	
	Examiner	Art Unit	
	Jason M Han	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *2 and 6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5 and 7-19* is/are rejected.

7)☒ Claim(s) *1,5,15 and 16* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/4/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to independent Claim 1 have been considered but are moot in view of the new ground(s) of rejection.

The following claims have been rejected in light of the specification, but rendered the broadest interpretation [MPEP 2111], wherein all structural limitations have been addressed.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In line 3 of the claim, applicant cites "a bottom", which should be rephrased to read "a bottom end" in order to remain consistent and to provide basis for "the bottom end" in the following line. Appropriate correction is required.

3. Claim 1 is further objected to because of the following informalities: In line 15 of the claim, applicant recites the limitation "one pole". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

4. Claim 5 is objected to because of the following informalities: Applicant recites the limitation "first conductor" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

5. Claim 15 is objected to because of the following informalities: Typographical error – in line 7 of the claim, "first and sections" should read as "first and second sections". Appropriate correction is required.

6. Claim 15 is further objected to because of the following informalities: Applicant recites the limitation "battery chamber sections" in line 8 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

7. Claim 15 is further objected to because of the following informalities: Applicant recites the limitation "cylindrical contact" in lines 19 and 21 of the claim. Please use consistent language, whereby the applicant refers to a "generally cylindrical, conductive contact" beforehand. Appropriate correction is required to avoid lack of antecedent basis.

8. Claim 16 is further objected to because of the following informalities: Applicant recites the limitation "cylindrical contact" in line 2 of the claim. Please use consistent language, whereby the applicant refers to a "generally cylindrical, conductive contact" beforehand. Appropriate correction is required to avoid lack of antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6305832) in view of Kaye et al. (U.S. Patent 3737650).

10. With regards to Claim 1, Huang discloses an illumination device including:

- a molded plastic housing [Figures 1-4: (20); Column 1, Lines 12-13] having a top end [Figures 1-4: (221)], a bottom end [Figures 1-4: (213)], light emitting end [Figures 1-4: (223)], and a longitudinal, centerline axis extending from the top end to the bottom end, whereby the housing includes a disc shaped battery chamber section [Figures 1-4: (214, 224)] at the top end with an internal disc shaped chamber, and an elongate projecting hollow tube section [Figures 1-4: (10)] at the bottom end joined to the disc shaped battery chamber section;
- the chamber section having a centerline axis forming an angle with a centerline axis of the hollow tube section, the chamber section further including a first, generally planar side [Figures 1-4: (21)] comprising a removable cover for the battery chamber and an opposed non-conductive, integral, generally planar side [Figures 1-4: (22)], whereby the hollow tube section has an open end [Figures 1-4: (11)] at the bottom end;
- a bulb mounted in the tube section at the bottom end [Figures 1-4: (30)]; and
- a disc shaped battery [Figures 1-4: (40)] in the disc shaped chamber of the chamber section having an electrical connection from one pole of the battery to the bulb.

Huang does not specifically teach the opposed non-conductive side having a clip support that is utilized within a circuit assembly, whereby a conductive pocket clip member is attached to the outside of the clip support side of the chamber section of the housing, including conductive elements through the support surface electrically connected to another pole of the battery in the chamber section, and further where the hollow tube section includes a passage aligned with the clip member so that it is connectable to a second circuit conductor electrically connected to the bulb in the hollow tube section by projecting through the passage to complete a circuit with the battery. The pocket clip is formed from an elastic, conductive material that is normally disengaged from the second circuit conductor, so that to activate the bulb, the clip member is elastically deformed to engage the second circuit conductor.

Kaye teaches a circuit assembly wherein a battery source [Figure 1: (14, 16)] within a housing [Figure 1: (12)] is in electrical communication [Figure 1: (16-1, 18B)] from one pole of the battery to a light bulb [Figure 1: (18)], a pocket clip member [Figure 1: (20)] including conductive elements [Figure 1: (20B-20D)] that pass through the housing and are electrically connected to another pole of the battery [Figure 1: (20C, 20D)], whereby the clip member is also connectable to a second circuit conductor [Figure 1: (30-1)] that is electrically connected to the bulb by projecting through an aligned passage [Figure 1: (12A-1)] in the housing and completing the circuit with the battery. The pocket clip is of an elastic, conductive material and is normally disengaged from the second circuit conductor, unless properly utilized by a user [Column 2, Line 53 – Column 4, Line 13].

It would have been obvious to modify the opposed non-conductive side of the illumination device of Huang to incorporate the conductive pocket clip member of Kaye in order to provide greater flexibility and accessibility, whereby a user may simply store away the device by clipping onto an article when not in use. In addition, it is commonly known and obvious to those skilled in the art to implement a conductive clip member as a means for completing an illumination circuit assembly.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6305832) in view of Kaye et al. (U.S. Patent 3737650) as applied to Claim 1 above, and further in view of Cooper et al. (U.S. Publication 2003/0142489).

Huang in view of Kaye discloses the claimed invention as cited above, but does not specifically teach the diameter of the tube in the range of 1/8" to 3/8".

Cooper teaches an inspection lamp incorporating an LED [Figure 1: (16)] of 0.38 inches in diameter [Page 2, Paragraph 13], whereby it is connected to a cylindrical tube of similar but larger diameter [Figure 1: (20)].

It would have been obvious to modify the illumination device of Huang with the conductive pocket clip member of Kaye to further incorporate a similar diameter for the cylindrical tube of Cooper, so as to ensure the light bulb or LED is stably positioned and encompassed within the tube.

12. Claims 4-5 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6305832) in view of Kaye et al. (U.S. Patent 3737650) as applied to Claim 1 above, and further in view of Galli (U.S. Patent 6523973).

13. With regards to Claim 4, Huang in view of Kaye discloses the claimed invention as cited above, but does not specifically teach bulb member being selected from the group consisting of an IR LED bulb, a UV LED bulb, and a white light LED bulb.

Galli teaches a gallium LED that emits a soft blue wavelength of light [Column 3, Lines 23-31]. It is also obvious that an LED would fall into one of infrared, ultraviolet, or white light emission categories.

It would have been obvious to modify the illumination device of Huang with the conductive pocket clip member of Kaye to further incorporate the LED of Galli in order to provide a durable, long life, efficient, low power consuming, and low cost light source, which are commonly known benefits of light emitting diodes.

14. With regards to Claim 5, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Galli teaches at least one conductive spring member [Figure 11: (102)] that is positioned in a battery chamber intermediate a cover [Figure 11: (12)] and a battery [Figure 11: (16, 18)] for connection to the battery.

15. With regards to Claim 7, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Galli teaches a plurality of disc shaped batteries in series [Figure 11: (16, 18)].

16. With regards to Claim 8, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above except for the second conductor being a generally cylindrical shaped plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the second

conductor into a generally cylindrical shaped plate, since it has been held to be within the general skill of a worker that mere change of form or shape of an invention involves only routine skill in the art. *Span-Deck Inc. c. Fab-Con, Inc. (CA 8, 1982)* 215USPQ 835. In this case, it is an obvious engineering decision that one could easily have modified or constructed the second conductor into a cylindrical shaped plate in order to accommodate and be aligned with the hollow tube section. Doing so may further simplify assembly and manufacturing of the device.

17. With regards to Claim 9, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches the pocket clip member being attached to a battery chamber section and including at least one contact prong [Figure 1: (20C, 20D)] connected to a battery [Figure 1: (14)].

18. With regards to Claim 10, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, both Kaye [Figures 7-9] and Galli [Figure 11] teach a housing having first and second mirror image sections. Such a configuration is an obvious engineering decision and principle, whereby mirror image sections may reduce cost of manufacturing and may further simplify assembling and maintenance of the device.

19. With regards to Claim 11, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Huang teaches the disc chamber being generally cylindrical [Figures 1-4: (214, 224)] and the hollow tube section [Figures 1-4: (10)] being at least three times as long as the diameter of the disc chamber section. Also, a typical coin battery diameter may have the size of ~0.8

inches. Assuming the battery chamber is of relatively similar size (~1 inch), it would have been obvious to construct the device to have a cylindrical tube with length of at least 3 times that size, which is ~3 inches. Anything smaller would not be in the scope of the invention, wherein an adequate extension of a light is needed to illumine darkly constricted areas.

20. With regards to Claim 12, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches the second conductor/plate including an axial slot [Figure 1: (30-2)] and the inside of a hollow tube section including a rib [Figure 1: (26-3)] for engaging the plate slot.

21. With regards to Claim 13, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Huang teaches the mirror image sections having opposed tabs [Figures 1-4: (212)] and receptacles [Figures 1-4: (222)] that engage for alignment and attachment of the sections together.

22. With regards to Claim 14, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches first and second walls [Figure 3: (42-1, 42-2)] within a hollow tube. It has also been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

23. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S. Patent 6305832) in view of Kaye et al. (U.S. Patent 3737650), and further in view of Galli (U.S. Patent 6523973).

24. With regards to Claim 15, Huang discloses an illumination device including:

- a first molded plastic housing section [Figures 1-4: (22)] that includes an elongate, hollow tubular section [Figures 1-4: (10)] and a connected disc battery chamber section [Figures 1-4: (214, 224)] joined to the tubular section, wherein the tubular section is of a generally semi-cylindrical tube, and whereby the battery chamber section has a disc shaped battery chamber connected to the tubular section;
- a second molded plastic housing section [Figures 1-4: (21)] that is a generally mirror image of the first housing section, whereby the hollow tube includes an open end [Figures 1-4: (11)]; (the examiner makes note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense; *In re Hutchinson*, 69 USPQ 138);
- a light bulb [Figures 1-4: (11)] in the hollow tube at the open end;
- a disc shaped battery [Figures 1-4: (40)] in the battery chamber; and
- a first lead in the housing from the bulb [Figures 1-4: (32)] to a first pole of the battery.

Huang does not specifically teach a second lead in the housing to a generally cylindrical, conductive contact in the hollow tube retained in alignment with a passage formed through a sidewall of the tube, nor a flexible, conductive pocket clip attached by prongs to the chamber section of the first housing section, whereby the prongs are

electrically connected to a second pole of the battery, wherein the clip includes a contact end aligned with the passage and is elastically deformable to electrically contact the generally cylindrical, conductive contact by extending through the passage, and further where the inside of the hollow tube includes wall sections for maintaining the generally cylindrical, conductive contact aligned with the passage.

Kaye teaches a second lead [Figure 1: (20E)] in a housing [Figure 1: (10)] to a generally cylindrical, conductive contact [Figure 1: (20C, 20D)] in a hollow tube retained in alignment with a passage [Figure 1: (12A-1)] formed through a sidewall of the tube. In addition, Kaye teaches a flexible conductive pocket clip [Figure 1: (20)] attached by prongs [Figure 1: (20C, 20D)] within a battery chamber of the housing so that the prongs are electrically connected to a second pole of a battery [Figure 1: (14, 16)], wherein the clip includes a contact end [Figure 1: (20-1)] aligned with the passage and is elastically deformable to electrically contact the generally cylindrical, conductive contact by extending through the passage, and further where the inside of the hollow tube includes wall sections [Figure 3: (42-1, 42-2)].

Neither Huang nor Kaye specifically teaches the light bulb being an LED bulb.

Galli teaches a gallium LED that emits a soft blue wavelength of light [Column 3, Lines 23-31].

It would have been obvious to modify the illumination device of Huang to incorporate the conductive pocket clip member of Kaye in order to provide greater flexibility and accessibility, whereby a user may simply store away the device by clipping onto an article when not in use. In addition, it is commonly known and obvious to those

skilled in the art to implement a conductive clip member as a means for completing an illumination circuit assembly.

It would then have been advantageous and obvious to modify the illumination device of Huang with the conductive pocket clip member of Kaye to further incorporate the LED of Galli in order to provide a durable, long life, efficient, low power consuming, and low cost light source, which are commonly known benefits of light emitting diodes.

25. With regards to Claim 16, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches the hollow tube including a wall [Figure 3: (42-1, 42-2)] adjacent each side of the passage to maintain the generally cylindrical, conductive contact aligned with the passage.

26. With regards to Claim 17, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches the conductive contact and hollow tube including engagement elements [Figure 1: (20E, 26-1, 26-2, 26-3)] for maintaining the conductive contact in alignment in the hollow tube.

27. With regards to Claim 18, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Kaye teaches the engagement elements including a conductive contact slot [Figure 1: (20E)] and the inside of the hollow tube including a rib to engage the slot [Figure 1: (26-1, 26-2, 26-3)].

28. With regards to Claim 19, Huang in view of Kaye, and further in view of Galli discloses the claimed invention as cited above. In addition, Huang teaches the battery section of the second housing including a removable cover [as best seen in Figure 1: (21)].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

US Patent 5335150 to Huang;

US Patent 5663828 to Knowles et al;

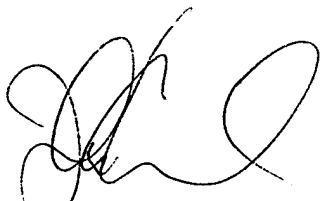
US Patent 6056415 to Alfred, III et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (1/20/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER